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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,467	12/12/2003	Veronique Ferrari	244818US0	8836
22850 7590 07/30/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT 1615	PAPER NUMBER
			NOTIFICATION DATE 07/30/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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# Office Action Summary

Application No.

10/733,467

Applicant(s)

FERRARI ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 74-145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74-145 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/2/07, 7/24/06,
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of election filed on 5/14/07 and IDS filed on 3/22/07, 7/24/06, 1/23/06, 10/13/05, 12/6/04 and 5/19/04.

Receipt is also acknowledged of preliminary amendment filed on 1/25/07. Preliminary amendment canceled claims 1-73 and added claims 74-145. Claims 74-145 are pending in the application and the status of the application is as follows:

#### ***Information Disclosure Statement***

The provisional applications have not been considered as they are in French.

This application is a CIP of 10/622,689 07/21/2003 and is a CIP of 10/617,048 07/11/2003  
and claims benefit of 60/438,770 01/09/2003  
and claims benefit of 60/438,782 01/09/2003  
and is a CIP of 10/323,649 12/20/2002 PAT 6,916,464  
and is a CIP of 10/320,601 12/17/2002  
and is a CIP of 10/320,599 12/17/2002  
and is a CIP of 10/320,600 12/17/2002 ABN  
and is a CIP of 10/170,655 06/14/2002  
and is a CIP of 10/170,549 06/14/2002 PAT 7,078,026  
and is a CIP of 10/170,566 06/14/2002  
and is a CIP of 10/166,760 06/12/2002 ABN  
and is a CIP of 10/166,650 06/12/2002 ABN  
and is a CIP of 10/166,755 06/12/2002  
and is a CIP of 10/166,648 06/12/2002 ABN  
and is a CIP of 10/166,762 06/12/2002 PAT 6,958,155

There is no support in all the parent application for the species elected and as such the filing date of the instant application is 12/1/2/03. If applicants disagree with the examiner they are requested to point out support in all the parent applications for the species and the combination of this species with film former (MQ or MK resin) and volatile solvent.

Applicant elected the species the specie of Nylon 611/dimethicone copolymer of example 27).

***Election/Restrictions***

Applicant's election with traverse of species of example 27 in the reply filed on 5/14/07 is acknowledged. The traversal is on the ground(s) that the reason underlying the designation by the Office of the different copolymers as being patentably distinct is not explained in sufficient detail or by example, and as such represents only a conclusion, particularly in view of the fact that the identified species are related by operation and/or effect. This is not found persuasive because there is plethora of polymers or copolymers belonging to claimed "polyorganosiloxane homopolymer or copolymer". The specification does not describe different species under "polyorganosiloxane polymer and copolymer" and it's a serious search burden to examine all the polymers. Additionally claims do not recite any specific formula. The expression "polyorganosiloxane" includes various volatile and non-volatile polymers and the expression also includes any polymer with the polyorganosiloxane moiety attached to the polymer. The requirement is still deemed proper and is therefore made FINAL.

Applicant elected species belonging to example 27. The species is identified as "DC 2-8179 GELLANT, BATCH # 18841-9". Search on Google did not yield any results with DC 2-8179. The examiner contacted Dow Corning for any product data sheet with respect to 2-8179 gellant of example 27. There is no DC 2-8179 gellant. In view of the reasons above, art is not cited. The elected species fails to comply with 35 U. S. C. 112, first paragraph.

***Claim Rejections - 35 USC § 112***

Claims 74-145 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This written description rejection.**

This is a “written description” rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. *Vas-Cath Inc. V. Mahurka*, 19 USPQ2d 1111, states that applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought; he or she was in possession of the invention. The invention, for purposes of the “written description” inquiry, is “*whatever is now claimed*” (see page 1117).

A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). In *Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that, while applicants are not required to disclose every species encompassed by a genus, the description of the genus is achieved by the recitation of a representative number of species falling within the scope of the claimed genus. At section B (1), the court states “An adequate written description of a DNA ... requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention”. Hence, an adequate written description of the ingredients requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it.

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The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. However, the present claim encompasses numerous species that are not further described. Specification describes various polymers, but fails to describe the species belonging to each formula. See paragraphs 38-117. The elected species is described as “ DC 2-8179 “ gellant. There is no “ DC 2-8179” gellant. Applicantst did not provide a structure for this polymer. What is the structure of this polymer? Does DC2-8179 have only the polymer or any other component? If it has more than one component, then applicants did not elect a polymer species instead a composition that has the polymer and another ingredient.


The description requirement of the patent statue requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder* 736 F.2d 1516, 1521, 222 USPQ 369, 372-373 (Fed. Cir. 1984). Accordingly, it is deemed that the specification fails to provide adequate written description for the elected species belonging to “ polyorganosiloxane group ... hydrogen interactions”.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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